UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,328	10/07/2004	Bardo Schmitt	259240US0PCT	1797

22850 7590 11/04/2010

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
PEZZUTO, HELEN LEE	
ART UNIT	**PAPER NUMBER**
1762	

NOTIFICATION DATE	DELIVERY MODE
11/04/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARDO SCHMITT,
JOACHIM KNEBEL and PATRIK HARTMANN

Appeal 2009-006501
Application 10/509,328
Technology Center 1700

Before CHARLES F. WARREN, MARK NAGUMO, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1-11, 21-23, 27-29, 33, 35, and 37 in the

---

[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

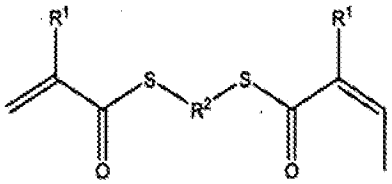
Office Action mailed January 25, 2007 (Office Action). 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

We reverse the decision of the Primary Examiner.

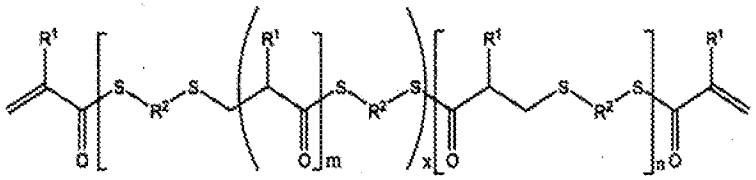
Appealed claim 1 illustrates Appellants' claimed invention of a process for preparing a transparent plastic, and is representative of the claims on appeal. We copy appealed claim 1 as it stands of record at page 4 of the Amendment filed October 23, 2006, and set forth in the Claim Appendix at page 12 of the Appeal Brief:

1. A process for preparing a transparent plastic, comprising:

polymerizing a mixture comprising the compounds of the formula I and formula II



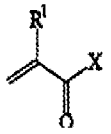
(I)



(II)

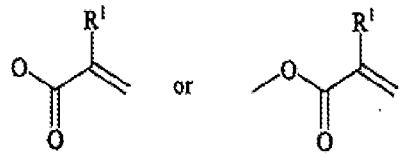
wherein R^1 is independently at each instance hydrogen or a methyl radical, R^2 is independently at each instance a linear or branched, aliphatic or cycloaliphatic radical or a substituted or unsubstituted aromatic or heteroaromatic radical, and m and n are each independently an integer of not less than 0, subject to the proviso that $m + n > 0$, and

wherein the mixture contains more than 10 mol%, based on the total amount of the compound as per formula (I) and (II), of compounds of the formula (II) wherein $m + n = 2$, prepared by reacting, in the presence of a solvent L, 1.0 to less than 2.0 mol of at least one compound of the formula (III)

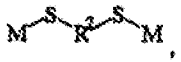


(III)

where X is chlorine or a radical of formula



with one mole of at least one polythiol of the formula (IV)



(IV)

where M is independently at each instance hydrogen or a metal cation; wherein the solvent L is at least one of acetone, acetonitrile, acetophenone, benzyl acetate, n-butyl acetate, quinoline, chlorobenzene, o-chlorotoluene. m-chlorotoluene, p-chlorotoluene, o-dichlorobenzene, m-dichlorobenzene, diethyl ether, diisopropyl ether, dimethyl phthalate, dipropyl ether, ethyl acetate, ethyl benzoate, ethyl butyrate, ethyl formate, ethyl salicylate, isoquinoline, 2-methoxyethyl acetate, methyl acetate, methyl benzoate, methyl butyrate, methyl ethyl ketone, methyl formate, methyl isoamyl ketone, methyl isobutyl ketone, methyl propionate, 2-methylpyridine, N-methyl-2-pyrrolidone, methyl salicylate, nitrobenzene, o-nitrotoluene, m-nitrotoluene, p-nitrotoluene, 2-pentanone, 3-pentanone, phenyl acetate, propyl formate, pyridine, tetrahydrofuran or mixtures thereof.

Appellants request review of the grounds of rejection under 35 U.S.C. § 103(a) advanced on appeal by the Examiner: claims 1-11, 21-23, 27-29, 33, 35, and 37 over Bader (US 5,384,379) in view of Esch (Fr. 2 771 411 A1), the latter reference applying only to claim 8;[2] and 1-11, 21-23, 27-29, 33, and 35 over Smith (US 6,342,571 B1). App. Br. 4-5; Ans. 3 and 5.

Appellants do not request review of the ground of rejection of claims 1-11, 21-23, 27-29, 33, and 35 under 35 U.S.C. § 102(e) over Smith of record in the Office Action and advanced on appeal by the Examiner.

---

[2] The record contains the translation of Esch prepared for the USPTO by The Ralph McElroy Translation Company (PTO 06-3180 March 2006).

App. Br. 5 and 10-11; Ans. 5 and 11-12; Off. Ac. 5.

Opinion

We find that appealed claim 1 was introduced into the record in the Amendment filed October 23, 2006, and is accurately reproduced in the Claim Appendix to the Appeal Brief. Amendment filed October 23, 2006, at 4; App. Br. 12. Thus, formulae (I) and (II) in appealed claim 1 do not contain "errors" as contended by the Examiner in the Answer. Ans. 3.

We find that the grounds of rejection advanced on Appeal by the Examiner and the arguments advanced in the Briefs are directed to the claimed invention encompassed by the version of claim 1 at page 2 of the Amendment filed January 3, 2006, and shown in the Claim Appendix at page i in the Reply Brief, and not to the claimed invention encompassed by appealed claim 1. *See generally* Ans.; *see generally* Brs. Indeed, formulae (I) and (II) of this version of claim 1 are free of the "errors" in Appealed claim 1 alleged by the Examiner. Ans. 3.

We further find that formula (I) in appealed claim 1 corresponds to the formula (I) inserted into the amendment to page 5, line 16 through page 6, line 16 of the Specification at page 2 of the Amendment filed October 23, 2006. We find no other recitation of formula (I) as set forth in appealed claim 1 in the Specification and original claims. We find that formula (II) as set forth in appealed claim 1 appears nowhere in the Specification and the original claims. *See generally* Specification and original claims.

We find that appealed claim 1 does not specify the definition of subscript "x," and determine that the significance of "$(\ )_x$" in formula (II) is not apparent from appealed claim 1 or the Specification and the original

claims. Indeed, while Appellants state that formula (II) represents "a material that has oligomeric and/or polymeric portions (e.g., those portions of the compound of formula (II) which are subscripted with m, n, or x)" in summarizing the claimed invention encompassed by appealed claim 1, Appellants do not otherwise explain formula (II) or specify basis in the Specification for the same. App. Br. 2-3. Thus, we find no basis in appealed claim 1 and the Specification and original claim on which to interpret formula (II).

Accordingly, on this record, we reverse the grounds of rejection of claims 1-11, 21-23, 27-29, 33, 35, and 37 under 35 U.S.C. § 103(a) over Bader in view of Esch, and of claims 1-11, 21-23, 27-29, 33, and 35 under 35 U.S.C. § 102(e), or in the alternative, under 35 U.S.C. § 103(a) over Smith advanced on appeal by the Examiner, for two reasons. First, we cannot interpret formula (II) of appealed claim 1, on which all other appealed claims depend, and thus we determine that the appealed claims are indefinite under 35 U.S.C. § 112, second paragraph. Indeed, the appealed claims are indefinite to the extent that it is impossible to ascertain the propriety of the Examiner's grounds of rejection without undue speculation. Thus, we reverse the grounds of rejection pro forma. *See In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). Second, while Appellants did not request review of the ground of rejection under § 102(e), on this record it is apparent that the Examiner's ground of rejection under this statutory provision has not been applied to appealed claim 1. Thus, we cannot determine whether Appellants'

contention that Smith does not describe the "claimed method" addresses the ground of rejection of appealed claim 1. App. Br., e.g., 10-11.

The Primary Examiner's decision is reversed.

REVERSED

OBLON SPIVAK MCCLELLAND
MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314